

HONEYWELL'S REBUTTAL STATEMENT

Equivalent Unforeseeable According to Sundstrand's 2001 Position

- Sundstrand's "Control Hall of Fame" Expert Shinskey
 - DELPQP is a "unique measure of potential surge conditions" that was "not described elsewhere in patents or prior art." (11/10/00 Report at 9.)
 - Had never seen DELPQP "in any work that I had ever done or in any publication that I have ever read." (2001 Trial Tr. at 1335.)
 - The "only purpose" of inlet guide vane position in the APS 3200 "is to protect against this possibility [of the system incorrectly interpreting a high flow condition as a low flow condition], and it's caused based on the unique characteristic of the DELPQP measurement as a function of flow." (2001 Trial Tr. at 1383.)

Equivalent Unforeseeable According to Sundstrand's 2001 Position

- Sundstrand's Own Statements

- “The APS 3200’s only use of inlet guide vane position is to deal with a problem unique to the unconventional parameter the APS 3200 uses to measure the movement of air through the compressor. ... The APS 3200’s surge control system uses a unique parameter measurement ... called ‘DELPQP’ and referred to as the ‘Static Pressure Parameter’ because it uses only static pressures - measures the rise in pressure across the compressor’s diffuser.”

(Sundstrand JMOL Br. at 3, 7.)

- “But DELPQP has the odd characteristic that when airflow reaches an extremely high level, DELPQP’s value peaks and then actually starts to decrease even as airflow increases. ... Honeywell’s own expert admitted that the high flow logic addresses this unusual behavior of the 3200’s DELPQP parameter.”

(Sundstrand Appellant Brief at 35-36.)

Sundstrand's Strategy Lacks Credibility

Sundstrand at 2001 Trial

“A: My conclusion was there were *many references of prior art* that included all of the elements that were claimed in the Honeywell patent, and these -- this prior art were publications that predated the filing of the application for the Honeywell patents.”

2001 Trial Tr. at 1425-26
(Shinskey)

Sundstrand at 2006 Remand

“*Mr. Shinskey had not conducted a search of the prior art* for a flow parameter like the APS 3200 used ...”

Sundstrand Trial Br. at 17

Japikse Admitted the Equivalent is Unique

- The APS 3200 Surge Control System is Not in the Prior Art

Remand Tr. at 314 (Japikse)

- Q: “The first one you ever saw where the inlet guide vane position was used to do that ignore or lockout function was the APS 3200?”

- A: “Yes.”

Remand Tr. at 361-62 (Japikse)

B Factor Test Did Not Work

- In September 1994 Sundstrand and Turbomeca considered the “[p]ossibility of eliminating T7 from the B-Factor Calculation in order to provide a more reliable b-factor,” or “[e]liminat[ing] the dual solution of B-Factor by moving the diffuser holes.”

(PTX 1134)

No Credible Evidence the L1011 Ever Experienced the Double-Solution

- Fig. A7 shows a smooth, rising curve
(PTX 1066 at SUND 006011, 006029.)
- Figure 9 of DTX 104 relates to the “L-1011 APU Surge Control *Redesign Feasibility Study*.”
(HON ¶¶84-85.)
- HSC Demonstrative 18 -- drawn by Brown at trial -- lacks credibility.
(HON ¶86.)

LOSS

(1949 U.S. Patent No. 2,470,565) - DTX 313

No measurement of pressure

No input of a pressure measurement into a surge control system

No pressure taps to measure pressure; simply conduits through which the air can flow

No use of measured IGV position and static pressure sensors to determine a flow-related parameter in the operation of a surge control valve

No surge control system that controls surge using a measurement of IGV position in response to a flow-related parameter

Glennon

(1979 U.S. Patent No. 4,164,033) - DTX 327

Merely describes that flow increases when the IGVs are more “open”

Not an APU surge control system

No use of measured IGV position and pressure sensors to determine flow-related parameter

Found not to be invalidating prior art at the Feb 2001 jury trial

Measures pressure differential at the “inlet of the compressor” instead of between the entrance of the diffuser and the exit of the scroll.

‘033 Patent, Col. 3, ll. 22-25.

Sundstrand's New Arguments Re: Application Claim 7 Fail

- “Substantially independent of the temperature of the compressed air”
 - This limitation never appeared in Application Claim 7
(JTX 31 at HSB 401430-31)
 - Examiner never mentioned temperature as a basis for rejection of Application Claim 7
(*Id.* at HSB 401457)
 - Examiner found the “use of the difference between total and static pressure would have been obvious”
(*Id.* at HSB 401457)
 - Cannot import limitations from the specification into the claim
(*Varco v. Pason Sys.*, 436 F.3d 1368, 1373 (Fed Cir. 2006))
 - Claim 8 included this limitation and was allowed
(JTX 31 at HSB 401466)

Sundstrand's New Arguments Re: Application Claim 7 Fail

- “Comparator means sharing an adjustable control set point for representing said desired value of said parameter.”
 - This limitation never appeared in Application Claim 7 (JTX 31 at HSB 401430-31)
 - Examiner never mentioned comparator, set point or parameter as a basis for rejection of Application Claim 7 (*Id.* at HSB 401457)
 - Examiner found the “use of the difference between total and static pressure would have been obvious” (*Id.* at HSB 401457)
 - Cannot import limitations from the specification into the claim (*Varco v. Pason Sys.*, 436 F.3d 1368, 1373 (Fed Cir. 2006))
 - Claim 8 included this limitation and was allowed (JTX 31 at HSB 401466)

Biagro Supports Honeywell's Position

- Reaffirmed *Insituform* -- “the reason for the amendment and the alleged equivalent involved different aspects of the invention.”
(423 F.3d at 1306.)
- Patentee told Examiner that concentration of fertilizer distinguished invention from prior art and then added claim term specifying level of concentration.
(423 F.3d at 1306; HON ¶254.)
- Applicant thus explicitly put equivalent limitation at issue in prosecution.
(HON ¶255.)
- By contrast, neither by words nor actions did Honeywell specifically put IGV use at issue during prosecution.
(*Id.*)

Festo Supports Honeywell's Position

- Must “discern[] from the prosecution history” the “objectively apparent reason for narrowing amendment.”
Festo, 344 F.3d at 1369.
- Rejection in *Festo* was based on the Examiner’s confusion over whether the device was a “magnetic clutch.”
(*Id.* at 1372; HON ¶249.)
- In response, patentee amended claims to add “magnetizable” limitation.
(HON ¶249.)
- Equivalent was a nonmagnetizable sleeve.
- Applicant and examiner thus explicitly put equivalent limitation at issue.

(344 F. 3d at 1371; HON ¶249.)